LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
NOV 2 1966
JOHN F. DAVIS, CLERK

No. 623

In the

Supreme Court of the United States

OCTOBER TERM, 1966

SCOVILL MANUFACTURING COMPANY,
Petitioner,

vs.

GOLDBLATT BROTHERS, INC., and
THE IONA MANUFACTURING COMPANY,
Respondents.

SCOVILL MANUFACTURING COMPANY,
Petitioner,

vs.

CARSON PIRIE SCOTT & COMPANY and
WARING PRODUCTS CORPORATION,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

THOMAS F. MCWILLIAMS
53 W. Jackson Boulevard
Chicago, Illinois 60604
Attorney for Respondents

The Scheffer Press, Inc.—ANdover 3-6850

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1966

No. 623

SCOVILL MANUFACTURING COMPANY,

Petitioner,

vs.

GOLDBLATT BROTHERS, INC., and
THE IONA MANUFACTURING COMPANY,

Respondents.

SCOVILL MANUFACTURING COMPANY,

Petitioner,

vs.

CARSON PIRIE SCOTT & COMPANY and
WARING PRODUCTS CORPORATION,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Although the petition presents four questions for consideration by this Court, upon analysis of these questions it must be concluded that there is but a single question involved, and that question is, . . . Do claims 9 through 14 of Reissue Patent No. 24,607 cover the same intention as is disclosed in original Patent No. 2,755,900 upon which the reissue is based?

The Court of Appeals for the Seventh Circuit, in its opinion found:

> "Thus, reissue claims 9 and 14 inclusive call for a different combination of coupling members—not for the same invention disclosed in the original patent."[1]

Under the decision of this Court in *U.S. Industrial Chemicals, Inc.* v. *Carbide & Carbon Chemicals Corporation,* 315 U.S. 668, 675-676, and under the reissue statute, the Court of Appeals concluded that the claims added by reissue are invalid.

Original Patent No. 2,775,900 (Ex. Vol. P. 1) describes flexible coupling means for separable shafts, particularly a coupling means for operatively connecting the armature and agitator shafts of motor-driven disintegrating food mixers, also known as blenders or liquidizers. The original patent contained eight claims. The specification and drawings of the original patent describe the coupling means to consist of two identical members having flexible teeth of a particular configuration for interfitting engagement. Each of these rubber toothed members are described in detail as having particular faces, slopes, and configurations for interfitting engagement, one member driving the other. Each of the eight claims of the original patent called for "flexible coupling means for drivingly connecting a pair of separate shafts" and "comprising a coupling member fixed on each of said shafts", such coupling member being specifically defined to be one having particular flat faces and specific conformations. The specification recites, in referring to the drawings illustrating the flexible coupling members "it will be understood that these members are identical, but one is mounted on the armature shaft with its teeth upwardly directed, and the other is

---

[1] Petition Appendix A—page 7 a.

mounted on the agitator with its teeth directed downwardly, engaging each other when the parts are in operative position". None of the claims of the original patent were charged to be infringed.

Defendants made and sold a coupling device wherein one member was generally of the form shown in the original patent, being a member having rubber teeth sloped and with contacting faces of the kind shown in the original patent, but in which the other member of the coupling means was a rigid metal or plastic spoke-wheel with which the rubber toothed member engaged to form the coupling means.

The reissue application was filed, new claims were added, and the reissue patent was granted, adding claims 9 through 14 which are here charged to be infringed by the devices made by defendants.

With respect to these claims added by reissue, the Court of Appeals stated:

> "The factor common to claims 9 to 14 inclusive of the reissue patent, and which serves to distinguish them from claims 1 to 8 inclusive, is the introductory language of each of the added claims:
>
> > "In combination with a pair of separable shafts which are longitudinally and laterally movable relatively to each other, coupling means for drivingly connecting said shafts including flexible coupling member fixed on one of said shafts comprising . . ." etc.
>
> There follows in each of the added claims a description of the form and shape of such flexible member including details with respect to the contact face and the various inclined surfaces of the flexible toothed member in substantially the same language of a corresponding original claim but omitting the use of terminology which would indicate or call for the presence of an identical reciprocal member on the other shaft. Thus claims 9 to 14 inclusive do not define or

describe in any manner the other coupling member which together with the flexible member described is to form the "coupling means" claimed. These added claims however *do remove the limitation that the second coupling member*, which together with the flexible member described is to form the "coupling means for drivingly connecting" the two shafts, *be an identical flexible coupling member* as is required in claims 1 to 8 inclusive. This broadens and enlarges the scope of the claims of the original patent."[2]

The question before the Court of Appeals was whether or not there was *any indication* in the original patent that one of the flexible rubber coupling members claimed in said patent could be used with any coupling member other than an identical member to form coupling means. The Court examined the documentary evidence consisting of the patent claims, drawings and specification of the original patent and concluded that the "unspecified form of the second cooperating member" claimed by Seyfried in the reissue "is undisclosed either *generically* or *specifically* in any manner in the original patent" and that, therefore, "the patentee in effect interpolated a new feature * * * neither described, suggested nor indicated in the original patent" which caused his reissue patent to be "for an invention substantially different from that embodied in the original patent" and consequently "void and of no effect".

The Court of Appeals also reviewed the testimony of both the plaintiff's and defendants' experts and concurred in their agreement that at no place in the original patent is there any reference to any coupling means other than that consisting of two identical flexible members. The Court of Appeals in its opinion sets forth this testimony in detail.

---

[2] Petition Appendix, page 3a, 4a. Throughout this Brief emphasis supplied.

The Court of Appeals thus clearly held that the invention claimed by reissue claims 9 through 14 covered a coupling means different from the coupling means disclosed in the original drawings and specification in that "the original patent *disclosed* only the use of identical flexible coupling means to form the 'coupling means' claimed therein", whereas reissue claims 9 to 14 reveal a coupling means wherein one of the members is described as a flexible rubber toothed member but the other coupling member is not defined.

The reissue statute 35 U.S.C. § 251, provides that under certain circumstances the Commissioner of Patents may . . . "reissue the patent for the invention disclosed in the original patent . . .".

The statute is clear that the reissue may only be . . . "for the invention disclosed in the original patent". Since both plaintiff's and defendants' experts agreed that the only disclosure of the original patent was limited to a coupling means consisting of identical coupling members, and that the reissue claims were not so limited, the conclusion is inescapable, that the reissue claim are invalid.

This Court has on many occasions considered the various reissue statutes and has uniformly held that claims granted by reissue patents which are for inventions not specifically disclosed or described in the original patent are invalid.

The Court of Appeals below relied upon two of the decisions of this Court,—*Parker and Whipple Company* v. *Yale Clock Co.*, 123 U.S. 87, 98, and *U.S. Industrial Chemicals, Inc.* v. *Carbide & Carbon Chemicals Corporation*, 315 U.S. 668, 675-676. The Court quoted from the latter case as follows:

> "The question is whether, in the light of the disclosures contained in the two patents, they are for the

same invention. . . . If there by failure of disclosure in the original patent of matter claimed in the reissue, it will not aid the patentee that the new matter covered by the reissue was within his knowledge when he applied for his original patent."[3]

The Petition for the Writ as prayed for should be denied because:

A. The original Patent No. 2,755,900 describes and discloses in the specification and drawings, a coupling means consisting only of two identical coupling members, and the original claims are directed solely to this combination.

B. Claims 9 through 14 added by reissue are directed to a coupling means consisting of one of the members set forth in the original patent, for association with a different unspecified form of coupling member.

C. Both plaintiff's and defendants' experts agree that there is no disclosure anywhere in the original patent of a coupling means consisting of one flexible member with any member other than an identical member.

D. The reissue claims are therefore for an invention not disclosed in the original patent.

E. The reissue statute (35 U.S.C. § 251) provides for the reissue of a patent only for the invention disclosed in the original patent.

F. This Court has consistently held that reissue claims drawn to an invention not disclosed in the original patent are invalid. The opinion of the Court of Appeals is in complete harmony with the decisions of this Court.

Respectfully submitted,

THOMAS F. MCWILLIAMS,
53 West Jackson Boulevard
Chicago, Illinois 60604
Attorney for Respondents.

---

[3] Petition Appendix—Page 7 a.